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Steven Tischer

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EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,470

Applicant(s)

TISCHER, STEVEN

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant filed amendments and remarks dated June 29, 2006, in response to the office action mailed March 31, 2006. Claims 1,7,10,17,18,21,22,24, and 25 have been amended. Claims 1,10,21,22, and 24 are independent claims. Claims 7,17,18, and 25 ultimately depend from claims 1,10, and 24, respectively, with claims 17 and 18 both depending from claim 10. Claims 1-25 are pending and considered in this office action.

Pertaining to claim objections in the previous office action

Claim 18 has been amended to overcome the objection in the previous action, however, the claim now fails to further limit the subject matter of the claim from which it depends. The amendment to claim 10 renders claim 18 defective. Please see claim objection below.

Pertaining to rejections under 35 USC 102 in the previous office action

Claims 1-25 were rejected as being anticipated by Herz (Paper # 060324; US Patent No. 6,029,195). Claims 1,7,10,17,21,22,24, and 25 have been amended to avoid the prior art, warranting reconsideration.

Response to Arguments

With regard to claims 1-6, 9-16, and 18-24, applicant's arguments filed June 29, 2006, have been fully considered but they are not persuasive. Applicant argues that the

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prior art fails to teach or suggest the first data set generated by a digital video recording device. This is not correct, as will be further shown below under "Claim Rejections – 35 USC § 102."

Applicant's arguments, see remarks filed June 29, 2006, with respect to the rejection(s) of claim(s) 7-8, 17, and 25, under 35 USC § 102, have been fully considered and are persuasive in light of amendments to claims 7, 17, and 25. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made under Herz in view of Lammerhuber (US Pub. No. 2003/0079219) as will be further explained below under "Claim Rejections – 35 USC § 103."

Claim Objections

1. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim is defective because it depends from claim 10 and states, "the first device comprises one of either a computer, a cellular phone, or a digital video recording device." The amendment to claim 10 specifies, "the first device is a digital video recording (DVR) device." This renders claim 18 defective.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 9-16, and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz (Paper # 060324; US Patent No. 6,029,195).

Herz teaches all the limitations of Claims 1-6, 9-16, and 18-24. For example, Herz discloses a system for comparing attributes of multiple data sets to determine similarities and then create new data sets based on the similarities. Herz further discloses:

- determining when the entity selects a first service or product: generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.10); wherein the first data set is generated by a digital video recording device and includes a unique identifier associated with an entity, a date, a time and a title of a program or movie selected by the entity for recording on the digital video recording device (see at least abstract, column 32 line 65-column 33 line 59, column 43 line 53-column 44 line 49, column 39 line 57 – column 40 line 33. Please note: passages show that electronic media includes video and that video recording devices are among the potential devices that generate profile data. Please note: The particular information included in the data set is descriptive material and is not functionally involved in the recited steps

of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); first device configured to determine whether the entity purchases, submits an order for the first service or product (see at least column 5 lines 36-45, column 18 line 40-column 19 line 7, column 68 lines 5-10, column 77 lines 17-47); a first network device generates the first data set (see at least abstract, fig.1,2); a first device configured to determine when the entity selects a first service or product and generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.1,2,10,12); first device comprises one of a computer, a cellular phone, or a digital video recording device (see at least fig.1,2).

- determining when the entity selects a second service or product: generating a second data set having a second attribute associated with the second service or product (see at least abstract); a second network device generates the second data set (see at least abstract, fig.1,2); a second device configured to determine when the entity selects a second service or product and generating a second data set having a second attribute associated with the second service or product (see at least abstract, fig.1,2,10);
- generating a third data set based on the first and second attributes: when a portion of data associated with the first attribute is substantially similar to a

portion of data associated with the second attribute (see at least abstract, column 5 lines 6-20, column 26 lines 2-21); a third network device generates the third data set (see at least abstract, figs.1,2); a third device configured to generate a third data set based on the first and second attributes when a portion of data associated with the first attribute is substantially similar to a portion of data associated with the second attribute (see at least abstract, figs.1,2,10; column 5 lines 6-20, column 26 lines 2-21); third device is operably associated with a grid computer network (see at least abstract, figs.1,2); third device comprises a computer server communicating with the first and second devices (see at least figs.1,2); associating at least a first attribute of the first historic data set with at least a second attribute of the second historic data set, the first attribute being substantially similar to the second attribute and generating a third dynamic data set based on at least one of the first and second attributes of the first and second historic data sets (see at least abstract, figs.1,2,10; column 5 lines 6-20, column 26 lines 2-21).

- the data associated with the first attribute comprises textual data: and the data associated with the second attribute comprises textual data (see at least abstract, column 5 lines 6-20, column 9 lines 19-30, column 77 lines 17-47); generating the third data set based on the first and second attributes includes determining whether at least a portion of the textual data of the first attribute is identical to at least a portion of the textual data of the second attribute and forming the third data set having a third attribute containing at least a portion of

textual data from one of the first and second attributes (see at least abstract, column 5 lines 6-20, column 77 lines 17-47).

- entity comprises one of a person or a group of people: (see at least abstract, column 9 lines 31-42. Please note: the identity of the entity has no functional role in the method and a person or group of people are themselves not patentable subject matter.).
- A storage medium encoded with machine-readable computer program code for generating data sets associated with an entity: (see at least column 9 lines 19-30).
- generating a plurality of historic data sets by monitoring activities of a legal entity: (see at least fig.10, column 77 lines 17-47); identifying a plurality of attributes contained in the plurality of historic data sets (see at least figs.5,10, column 77 lines 17-47); determining a plurality of values wherein each value is associated with one attribute of the plurality of attributes and corresponds to a number of historic data sets of the plurality of historic data sets containing the one attribute (see at least fig.12); determining a plurality of dynamic data sets containing the attributes wherein the plurality of dynamic data sets are ranked based on the plurality of values (see at least abstract, fig.12, column 18 line 40-column 19 line 7, column 19 line 29-column 20 line 22, column 77 lines 48-67); iteratively generating the plurality of historic data sets by monitoring activities of the legal entity (see at least abstract, figs.5,10; column 20 line 47-column 21 line 4).

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Pertaining to method claims 1-6, 9, and 22-24

Rejection of claims 1-6,9, and 22-24 is based on the same rationale as noted above.

Pertaining to encoded storage medium claim 21

Rejection of claim 21 is based on the same rationale as noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-8,17, and 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (Paper # 060324; US Patent No. 6,029,195) in view of Lammerhuber (US Pub. No. 2003/0079219).

Herz teaches all of the above as noted under the 102(b) rejection and teaches a) a unique user identification, b) generating datasets of attributes of products or services, c) associating user identification with datasets, and d) determining the interest of the user in the products or services. Herz does not however disclose a data set generated by a cell phone equipped with a barcode scanner, including a universal product code from a barcode scanned by the barcode scanner, the universal product code corresponding to second service or product. Lammerhuber teaches a) a unique user identification, b) generating datasets of attributes of products or services, c) associating

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user identification with datasets, d) determining the interest of the user in the products or services, and also teaches a data set generated by a cell phone equipped with a barcode scanner, including a universal product code from a barcode scanned by the barcode scanner, the universal product code corresponding to a second service or product (see at least abstract, fig.1, page 1 paras.0004-0009). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Herz to include a data set generated by a cell phone equipped with a barcode scanner, including a universal product code from a barcode scanned by the barcode scanner, the universal product code corresponding to a second service or product as taught by Lammerhuber, in order to increase the range of commercial environments in which the system is useful, thereby increasing commerce using the system.

Pertaining to method claims 7-8 and 25

Rejection of claims 7-8 and 25 is based on the same rationale as noted above.

Examiner cites particular columns and line numbers in the reference as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the reference in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Guheen, US Patent No. 6,519,571 (Feb. 11, 2003); Teaches creation of data sets by various video recording means including digital video and teaches communication by cellular telephone, but does not teach creation of data sets by cellular telephone with attached barcode scanner.
- Okamoto, US Pub. No. 2002/0052877 (May 2, 2002); Teaches creation and integration of datasets created by tracking purchases and receiving information pertaining to transactions from cellular telephones equipped with barcode scanners.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
October 12, 2006



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